

ESTTA Tracking number: **ESTTA46382**

Filing date: **09/27/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Cellco Partnership d/b/a Verizon Wireless
Granted to Date of previous extension	09/28/2005
Address	180 Washington Road Bedminster, NJ 07921 UNITED STATES

Correspondence information	Russell H. Falconer Baker Botts LLP 30 Rockefeller Plaza44th Floor New York, NY 10112-4498 UNITED STATES nytmdpt@bakerbotts.com Phone:212 408-2564
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Applicant Information

Application No	78443400	Publication date	05/31/2005
Opposition Filing Date	09/27/2005	Opposition Period Ends	09/28/2005
Applicant	CINGULAR WIRELESS II, LLC 7277 164TH AVENUE NE REDMOND, WA 98052		

UNITED STATES

Goods/Services Affected by Opposition

Class 038. First Use: 20040414First Use In Commerce: 20040414

All goods and services in the class are opposed, namely: Telecommunications services, namely wireless transmission, uploading and downloading of voice, data, images, audio, video, signals, information, games, ring tones, and messages; wireless telephone communications services; wireless digital and analog voice messaging services; wireless text and numeric digital messaging services; electronic mail services; paging services; facsimile transmission services; Internet service provider and online service provider services, namely, providing multiple user access to a global computer information network, the Internet, wide area networks, local area networks, and private computer information networks; telecommunications services, namely, providing telecommunications connections and the electronic transmission of messages, data, orders, billing, payment and account information, that allow users to perform electronic business transactions via wireless telephones, handheld computers, and mobile data receivers and through a global computer information network, the Internet, wide area networks, local area networks and private computer information networks; wireless roaming services; telecommunications consultation; telematic sending of information

Attachments

Cingular's Signal Strength Icon.pdf (6 pages)

Signature

/Russell H. Falconer/

Name

Russell H. Falconer

Date

09/27/2005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF APPLICATION

Mark : Design of Signal Strength Icon

Applicant : AT&T Wireless Services, Inc. predecessor in interest to
Cingular Wireless II, LLC

Serial No. : 78/443,400

Filed : June 29, 2004

Published in the
Official Gazette : May 31, 2005

CELLCO PARTNERSHIP :
d/b/a VERIZON WIRELESS, :

Opposer, :

v. : Opposition No.

AT&T WIRELESS SERVICES, INC. :
predecessor in interest to
CINGULAR WIRELESS II, LLC :

Applicant. :

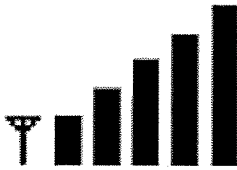
NOTICE OF OPPOSITION

Opposer, Cellco Partnership, a partnership organized and existing under the laws of the State of Delaware, having its principal place of business at 180 Washington Valley Road, Bedminster, New Jersey 07921 and doing business as Verizon Wireless (hereinafter referred to as “Verizon Wireless” or “Opposer”) believes that it will be damaged by registration to Applicant in International Class 38 of the design mark illustrated below in respect of

“telecommunications services, namely wireless transmission,
uploading and downloading of voice, data, images, audio, video,

signals, information, games, ring tones, and messages; wireless telephone communications services; wireless digital and analog voice messaging services; wireless text and numeric digital messaging services; electronic mail services; paging services; facsimile transmission services; Internet service provider and online service provider services, namely, providing multiple user access to a global computer information network, the Internet, wide area networks, local area networks, and private computer information networks; telecommunications services, namely, providing telecommunications connections and the electronic transmission of messages, data, orders, billing, payment and account information, that allow users to perform electronic business transactions via wireless telephones, handheld computers, and mobile data receivers and through a global computer information network, the Internet, wide area networks, local area networks and private computer information networks; wireless roaming services; telecommunications consultation; telematic sending of information”

as sought by United States Service Mark Application Serial No. 78/443,400, filed on June 29, 2004:



Verizon Wireless hereby opposes the application in-opposition. The grounds for the opposition are as follows:

1. Verizon Wireless is among the largest providers of wireless communications services in the United States with more than 45 million wireless voice and data customers. It employs more than 50,000 people nationwide and offers wireless voice and data services, other wireless telecommunications services and wireless telecommunications products, all of the highest quality, through approximately 1900 company operated stores and kiosks as well as through resellers, agents and affiliates.

2. For many years, and long prior to Applicant's claimed date of first use of the alleged mark-in-opposition, Verizon Wireless and its predecessors-in-interest have marketed, promoted and advertised wireless telecommunications services and products to consumers and to businesses on television, in newspapers, magazines, brochures, outdoor media and at public events. Among the most important commercial messages that Opposer and its predecessors have sought to convey in marketing, advertising and promoting wireless products and services is the reliability and range of services offered and provided to their wireless phone customers. Signal strength is an important factor in this regard. For example, on or about January 14, 2002, Verizon Wireless launched what has now become one of the most famous advertising campaigns in the United States. The campaign features the "Test Man" character who continuously tests Opposer's wireless network by placing calls from numerous, often unusual, locales throughout the country, inquiring "CAN YOU HEAR ME NOW?" and replying "GOOD" once he hears an affirmative response. These ads have appeared innumerable times on television and in a variety of print formats. Since the campaign's inception, Verizon Wireless has expended in excess of Three Hundred Million Dollars (\$300,000,000.00) in advertising and promotions which use and feature the slogan and service mark, "CAN YOU HEAR ME NOW? GOOD." This investment has resulted in over eighteen **billion** impressions, i.e., individual exposures to such advertisements which relate to the clarity, reliability and range of Opposer's wireless services.

3. On information and belief, virtually all wireless phone manufacturers and wireless telecommunication service providers, including Opposer and Applicant, and the wireless phones that they manufacture and/or distribute, have continuously utilized, since long prior to Applicant's claimed date of first use, functional, generic signal strength icons that consists of a series of vertical bars and an illustration of a cell tower or other device

representative or illustrative of the availability and strength of signal transmission. These signal strength icons are routinely displayed on wireless phones as well as being pictured, and their functionality described, in User Manuals for such phones. The signal strength icon of Applicant that is the subject of the application-in-opposition is illustrated below alongside reproductions of signal strength icons appearing on the screens of various wireless phones and the phone User Manuals of wireless phones distributed by third parties. These icons, shown in a size larger than that seen by consumers, are indistinguishable from the application-in-opposition. They typify such icon use in the wireless phone industry and represent actual signal strength icons that have been and continue to be used in that industry by Applicant, its suppliers and competitors.

Applicant



Audiovox



Samsung



Sprint



Qwest



4. On information and belief, Applicant's claimed mark is not entitled to registration because the mark is (i) primarily functional, (ii) generic, (iii) so highly descriptive as to be incapable of exclusive appropriation, and (iv) so commonly used by others in the industry that there has been no exclusive appropriation of this design by Applicant. As a result, the subject design does not and cannot function as a mark.

5. On information and belief, a signal strength icon used on phones distributed by Opposer, by Applicant and by others performs the function of informing the user of the availability and relative strength of the signal to a particular device.

6. On information and belief, wireless phones promoted, advertised and distributed by Opposer, its manufacturers and by Opposer's other competitors have been utilizing signal strength icons virtually indistinguishable from the mark-in-opposition since long prior to Applicant's claimed date of first use thereof.

7. On information and belief, virtually all wireless service providers that compete with Verizon Wireless and Applicant and virtually all manufacturers of wireless hand-sets utilize signal strength icons that are identified as such and that perform the function of informing the user of the availability and strength of that signal.

8. On information and belief, signal strength icons consisting of a series of vertical bars accompanied by a symbol of a telephone pole, cell tower or other similar generic design have long been used as a fundamental functional feature of wireless phones and wireless phone services. These icons serve as an essential visual confirmation that a signal has been received and/or as a measure of the strength of that signal and are synonymous with the generic words “signal strength.” As such, and in light of the ubiquitous nature of their use, signal strength icons are utilitarian and functional elements, unprotectable as a trademark.

9. On information and belief, numerous wireless phone manufacturers and providers of wireless phone services have long used and continue to use signal strength icons virtually identical to or indistinguishable from the signal strength icon that is the subject of the application-in-opposition in order to define for users a fundamental function of their wireless phones and other devices.

10. On information and belief, Applicant’s icon is generic or so highly descriptive of signal strength as to be unprotectable.

11. On information and belief, the signal strength icon that is the subject of the application-in-opposition is so widely used in the service category described in the application-in-opposition and has been used in that fashion for so many years that this symbol is generic or so highly descriptive as to be incapable of identifying source or distinguishing the wireless phone services of one provider from those of another.

12. Opposer and others who have used and continue to use signal strength icons such as that represented in the application-in-opposition are entitled to do so without limitation or interference. If the application-in-opposition issues to registration, Opposer, its manufacturers, and other manufacturers and distributors of wireless phones could be precluded from utilizing a design that is functional, generic, so highly descriptive as to be incapable of exclusive appropriation and so commonly used by others in the industry such that there has been no exclusive appropriation of that design by Applicant. Opposer and those in the wireless phone industry and other related fields should not have their freedom to use such a commonly used designation subject to unwarranted and inappropriate threat or attack or be subjected to threats of interference.


13. In view of the foregoing, Opposer would be damaged by issuance of a registration to Applicant within the meaning of 15 U.S.C. § 1063.

WHEREFORE, Opposer requests that this opposition be sustained and that registration be denied to Applicant on Application Serial No. 78/443,400.

Respectfully submitted,

BAKER BOTTS L.L.P.

Dated: September 27, 2005

By: 
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